

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:
Dettinger et al

Serial No.: 10/645,123

Confirmation No.: 7110

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Filed: August 21, 2003

Group Art Unit: 2164

Examiner: Melissa M. Chojnacki

For: ANNOTATION OF QUERY COMPONENTS

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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<u>Sept. 22, 2008</u>	<u>/Dolores Salaz/</u>
Date	Dolores Salaz

Dear Sir:

REPLY BRIEF

Applicants submit this Reply Brief to the Board of Patent Appeals and Interferences in response to Examiner's Answer mailed on August 6, 2008. While Applicants' maintain each of the arguments submitted in Applicants' previously submitted Appeal Brief, Applicants make the following further arguments in light of the Examiner's Answer.

Status of Claims

Claims 1-7, 18-21 and 30 are pending in the application. Claims 1-29 were originally presented in the application. Claim 30 has been added during prosecution. Claims 8-17 and 22-29 have been canceled without prejudice. Claims 1-7, 18-21 and 30 stand finally rejected as discussed below. The final rejections of claims 1-7 and 18-21 and 30 are appealed. The pending claims are shown in the attached Claims Appendix.

Grounds of Rejection to be Reviewed on Appeal

1. Rejection of claims 1-7, 18-21 and 30 under 35 U.S.C. 102(e) as being anticipated by *Gupta et al.* (U.S. Patent No. 6,956,593, hereinafter, "*Gupta*").

ARGUMENTS

I. THE EXAMINER ERRED IN REJECTING CLAIMS 1-7, 18-21 AND 30 UNDER 35 U.S.C. 102(e) AS BEING ANTICIPATED BY GUPTA.

The Applicable Law

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Applicants' Reply to the Examiner's Response to Arguments

In the Examiner's Answer, the Examiner argues that *Gupta* is directed to "annotating query components" because:

Gupta teaches client/server system, wherein annotations can be created corresponding to media content (See abstract). *Gupta* discloses a user interface that allows the user to open up a "'query' dialog box" wherein a user can search for annotations as well as "Add new annotations", within that "'query' dialog box" (See column 12, lines 39-67; column 13, lines 1-10).

Examiner's Answer, pp. 8-9. However, the Examiner's statement is incorrect. The user interface disclosed in *Gupta* does *not* allow a user to "Add new annotations" from within a "'query' dialog box." Instead, according to the sections cited by the Examiner, a user is only allowed to "Add new annotations" from within the "annotation toolbar." Thus, in *Gupta*, the creation of new annotations is in no way related to the queries being composed in the query dialog box. Accordingly, *Gupta* is *not* directed to "annotating query components" as the Examiner suggests. Applicants request that the rejection be withdrawn.

Furthermore, the Examiner argues that *Gupta* is directed to “annotating query components” because:

Gupta discloses that the user can select from a list of annotations to be included in the query but not only can the user select from predefined annotation sets but the user can also “create” new annotation to associate with the query through the user interface (See column 2, lines 39-53; column 16, lines 7-42; column 17, lines 52-67; column 18, lines 1-47).

Examiner’s Answer, pp. 8-9. However, the Examiner’s statement is again incorrect. In *Gupta*, a user *cannot* create a new annotation to associate with a query. Instead, according to the sections cited by the Examiner, a user is only allowed to associate the *overall user interface* with a *target annotation category* (for example, “Annotations by Students,” or “Annotations by Instructors”; *Gupta* refers to these as “annotation sets”), *Gupta* col. 2, lines 42-46, or associate a newly created annotation with a *target annotation category*, *Gupta* col. 2, lines 48-52.

The purpose of designating a *target annotation category* in *Gupta* is to facilitate query composition. For example, by specifying a “student” target annotation category the queries composed by a user will be restricted to returning only those annotations created by students. In other words, the target annotation category selection effectively contributes query logic to a user’s query without the user having to explicitly compose the specific query language for each query. Once the remaining part of the query is composed, the user executes the query and is presented with a result set containing those annotations that satisfy the query criteria. Of course, it is possible that no annotations satisfy the query criteria, in which case no results are returned. It should be clear, therefore, that the target annotation category is not an annotation. Rather, the target annotation category is query logic whose very purpose is to limit which annotations are ultimately returned in the result set for the executed query. Furthermore, what the Examiner refers to as “associating” a particular target annotation category (for example, “Annotations by Students”) with a dialog box merely serves to associate a *default selection* with that dialog box, so that the user need not input the same selection every time the user encounters the dialog box. There is no mention anywhere in *Gupta* of the ability to associate an annotation with a query, or the ability to

annotate a query. Accordingly, Gupta is *not* directed to "annotating query components" as the Examiner suggests. Applicants request that the rejection be withdrawn.

CONCLUSION

The Examiner errs in finding that:

Claims 1-7, 18-21 and 30 are anticipated by *Gupta*.

Withdrawal of the rejections and allowance of all claims is respectfully requested.

Respectfully submitted, and
S-signed pursuant to 37 CFR 1.4,

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